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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,433	10/14/2003	W. Todd Daniell	030455; 190250-1580	7279
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EXAMINER				
LAI, MICHAEL C				
ART UNIT		PAPER NUMBER		
2457				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/686,433

Applicant(s)

DANIELL, W. TODD

Examiner

MICHAEL C. LAI

Art Unit

2457

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 10, 11, 18-20 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 11, 18-20 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 4/19/2010
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to communications filed on 3/8/2010.

Response to Amendment

The examiner has acknowledged the amended claims 1, 10, 18, 19, and 25.

Claims 1-2, 10-11, 18-20, and 25-27 are pending.

Response to Arguments

Applicant's arguments filed 3/8/2010, with respect to the rejection(s) of claim(s) 1-2, 10-11, 18-20, and 25-27 under 35 U.S.C. 102(e) have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 10-11, 18-20, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel (US 6,839,737, hereinafter referred to as Friskel).

Regarding claim 1, Friskel discloses a method for initiating an instant messaging (IM) session, the method comprising:

determining whether a sender of a received email message is currently present at an Instant Messaging (IM) account [i.e., steps 706, 708] [Fig. 7 and col. 7, lines 31-46];

determining whether the sender of the received email message is a contact of a recipient of the received email message [i.e., step 704, the e-mail address of the sender is compared to the e-mail addresses in contacts file] [Fig. 7 and col. 7, lines 16-30]; and

in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, and in response to the recipient's selecting "chat", automatically launching an IM session with the sender [i.e., steps 710, 714] [Fig. 7 and col. 7, lines 47-61].

Friskel discloses the claimed invention except for the limitation: in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, automatically launching an IM session with the sender. As indicated above, Friskel discloses all the claimed invention except the recipient needs to select "chat." Friskel's invention provides a recipient an option to reply by email or "chat." Once "chat" is selected, it automatically launches an IM session with the sender (see at least Fig. 7 and col. 7, lines 47-61). A person of ordinary skill in the art, upon reading the reference, would also have recognized the desirability of improved methods of automatically launching an IM session with the sender without the extra action of selecting "chat", since the sender is known present at the IM account (i.e., ready for "chat") and is a contact (a trusted

person or a buddy) of the recipient. Thus, it would have been obvious to a person with ordinary skill in the art to try automatically launching an IM session with the sender in response to determining that the sender of the received email message is currently present at the IM account and in response to determining that the sender of the received email message is the contact of the recipient of the received email message, as a person with ordinary skill has good reason to do so within his or her technical grasp.

Regarding claim 2, Friskel further discloses the method of claim 1, wherein determining whether a sender of a received email message is currently present at an IM account includes extracting contact information from the email message, the contact information being associated with the sender of the received email message [i.e., step 706] [col. 7, lines 31-39].

Claims 10-11 are of the same scope as claims 1-2 respectively. They are rejected for the same reason as for claims 1-2 respectively.

Claim 18 is of the same scope as claim 1. It is rejected for the same reason as for claim 1.

Claims 19-20 are of the same scope as claims 1-2 respectively. They are rejected for the same reason as for claims 1-2 respectively.

Claim 25 is of the same scope as claim 1. It is rejected for the same reason as for claim 1.

Claims 26-27 are of the same scope as claims 1-2 respectively. They are rejected for the same reason as for claims 1-2 respectively.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Appelman et al. (US 6,912,564 B1) discloses a system for instant messaging the sender and recipients of an e-mail message.

Jenniges et al. (US 6,978,136 B2) discloses a method for automatically initiating a chat session between a user and personnel in the customer support department when the controller indicates that the customer support department is available.

Stewart et al. (US 7,317,928 B2) discloses exposing instant messenger presence information on a mobile device.

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL C. LAI whose telephone number is (571)270-3236. The examiner can normally be reached on M-F 8:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael C. Lai
05JUN2010

/YVES DALENCOURT/
Primary Examiner, Art Unit 2457